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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,109	04/08/1999	KOICHI SATO	P17387	7068

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EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
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2612

/2

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/288,109

Applicant(s)

SATO, KOICHI

Examiner

LUONG T NGUYEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/12/2003 has been entered.

Response to Arguments

2. Applicant's arguments filed on 10/14/2003 have been fully considered but they are not persuasive.

In re pages 8-9, Applicant argues that Nakamura fails to disclose a feature of the present invention, a versatile camera/printer system, in which a photographing operation (e.g., generating image data) and a printing (e.g., reproducing) operation can be performed by operating either an image data generating start mechanism (associated with the camera) or a printing operation start mechanism (associated with the printer), as discussed, at page 28, line 15 to page 29, line 3 of Applicant's specification.

In response, regarding claim 1, the Applicant recited in claim 1 with the limitation "a still video camera connectable to a printer, comprising an image data generating start mechanism,"

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this limitation can read that the camera/printer system comprises an image data generating start mechanism. And this shows that the claim does not require the camera includes or comprises an image data generating start mechanism. Therefore, the first push-button 13 in Nakamura can read on limitation “an image data generating start mechanism.” Nakamura discloses the first push-button 13 is used for taking picture and instructing printer device 12 of a hard copy (column 3, lines 42-46). In addition, the Applicant amended claim 1 with the limitation “selectively activating **one of** said image data generating start mechanism and a printing operation associated with said printer.” The Examiner considers that claim 1 as amended still do not distinguish from Nakamura patent. In addition, the Applicant recites the alternative limitation “one of” in the limitation “one of said image data generating start mechanism and a printing operation start mechanism.” Therefore, the prior art can only read on limitation “said image data generating start mechanism” or limitation “a printing operation start mechanism”. In this case, Nakamura discloses the first push-button switch 13 can take the image and print the image (figure 1, column 3, lines 23-55).

In re page 10, Applicant argues that claims 5 and 13 recite that the image data is printed by the printer in the reproduction mode in accordance with a second operation of either the printing operation start mechanism or the image data generating start mechanism. And the prior art does not disclose this feature.

In response, regarding claim 5, Applicant recited in claim 5 with the limitation “wherein, in said reproduction mode, said image data is printed by said printer in accordance with a second operation of one of said printing operation start mechanism and said image data generating start mechanism.” And regarding claim 13, the Applicant amended claim 13 with the limitation “by

selectively activating one of said printing operation start mechanism and said image data generating start mechanism.” It should be noted that the Applicant recites the alternative limitation “one of” in the limitation “one of said printing operation start mechanism and said image data generating start mechanism.” Therefore, the prior art can only read on limitation “said printing operation start mechanism” or limitation “said image data generating start mechanism”. In this case, Nakamura discloses the first push-button switch 13 can take the image and print the image (figure 1, column 3, lines 23-55).

In re page 10, Applicant argues that claim 6 recites that the photographing operation is performed in the photographing mode in accordance with a second operation of either the printing operation start mechanism or the image data generating start mechanism. And the prior art does not disclose this feature.

In response, regarding claim 6, Applicant recited in claim 6 with the limitation “wherein, in said photography mode, said photographing operation is performed in accordance with a second operation of one of said printing operation start mechanism and said image data generating start mechanism.” It should be noted that the Applicant recites the alternative limitation “one of” in the limitation “one of said printing operation start mechanism and said image data generating start mechanism.” Therefore, the prior art can only read on limitation “said printing operation start mechanism” or limitation “said image data generating start mechanism”. In this case, Nakamura discloses the first push-button switch 13 can take the image and print the image (figure 1, column 3, lines 23-55).

In re page 10, Applicant argues that claim 16 recites that the photographing operation is performed in the photographing mode and the reproduction mode in accordance with a first operation of either the release switch or the print start switch, and that the image is printed in the reproducing mode in accordance with a second operation of either the release switch or the print start switch. And the prior art does not disclose this feature.

In response, regarding claim 16, the Applicant amended claim 16 with the limitation “said photographing operation being performed in accordance with a first operation by selectively activating one of said release switch and said print start switch, said image being printed by said printer, in said reproduction mode, in accordance with a second operation of said release switch after said photographing operation is performed.” It should be noted that the Applicant recites the alternative limitation “one of” in the limitation “one of said release switch and said printing start switch.” Therefore, the prior art can only read on limitation “said release switch” or limitation “said print start switch”. In this case, Nakamura discloses the second push-button switch 28 takes the image (release switch, figure 1, column 3, lines 23-55).

In addition, it should be noted that claim 16 amended with the limitation “*said image being printed by said printer, in said reproduction mode, in accordance with a second operation of said release switch after said photographing operation is performed,*” the claim does not require image data printed by a second operation of the release switch. Therefore, Nakamura patent still read on claim 16. Nakamura discloses that after the second push-button switch 28 takes the picture image, the picture is printed by printer 12 (figure 1, column 3, lines 23-55).

In re page 10, Applicant argues that claim 17 recites the first operation comprises a continuous depression over a predetermined period, while the second operation comprises a

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single depression of less than the predetermined period. And the prior art does not disclose this feature.

In response, Nakamura discloses this feature. Nakamura discloses the second push-button switch 28 determines a timing at which a picture image is to be taken out and instructing the printer device 12 prints a hard copy, figure 1, column 3, lines 24-56).

In re page 11, Applicant argues that copy switch 17 does not constitute a wait operation, and the copy switch 17 of Nakamura must be manually operated by the user, whereas the waiting operation in Applicant's invention is automatically performed.

In response, the Examiner disagrees. Nakamura discloses a copy switch 17 for causing the printer device 12 to print the stored contents of a memory 16 provided in the printer 12 (column 3, lines 47-55). This clearly shows that there is "a waiting operation" after photographing operation is performed. Further, the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Verner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (US 4,942,477).

Regarding claim 1, Nakamura discloses a still video camera (optical device 1, figure 1, column 3, lines 5-10) connectable to a printer (printer 12, figure 1) provided with a printing operation start mechanism (copy switch 17, figure 1, column 3, lines 47-50), comprising an image data generating processor that performs (controller 10, figure 1, column 3, lines 32-35), in a photography mode, a photographing operation in which image data is generated according to said image formed by an optical system (lens 3, figure 1, column 3, lines 17-20); an image data generating start mechanism (first push-button 13, figure 1, column 3, lines 41-45); an image data transmitting processor (controller 10 and signal cable 11, figure 1, column 3, lines 35-42, column 4, lines 13-15) that transmits, in a reproduction mode, said image data to said printer; said image data generating processor being activatable in said photography mode, by said image data generating start mechanism (first push-button 13, figure 1, column 3, lines 41-45); and said image data transmitting processor being activatable, in said reproduction mode by said image data generating start mechanism, so that said printer carries out said printing operation (the first push-button switch 13 determines a timing at which a picture image is to be taken out and instructing the printer device 12 prints a hard copy, figure 1, column 3, lines 24-56).

It is noted that, the Applicant recites the alternative limitation "one of" in the limitation "one of said image data generating start mechanism and a printing operation start mechanism." Therefore, the prior art can only read on limitation "said image data generating start mechanism" or limitation "a printing operation start mechanism". In this case, Nakamura discloses the first

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push-button switch 13 can take the image and print the image (image data generating start mechanism, figure 1, column 3, lines 23-55).

Regarding claim 2, Nakamura discloses a release switch (second push-button switch 28, figure 1, column 3, lines 24-28).

Regarding claim 3, Nakamura discloses wherein after said photographing operation, an image is printed by the printer (column 3, lines 45-50).

Regarding claims 4 and 12, Nakamura discloses wherein said first operation is a continuous operation over a predetermined period of one of said printing operation start mechanism and said image data generating start mechanism (the second push-button switch 28 determines a timing at which a picture image is to be taken out, figure 1, column 3, lines 24-56).

Regarding claims 5 and 13, Nakamura discloses wherein, in said reproduction mode, said image data is printed by said printer in accordance with a second operation of one of said printing operation start mechanism and said image data generating start mechanism (the first push-button switch 13 instructs the printer device 12 prints a hard copy, figure 1, column 3, lines 40-50).

Regarding claim 6, Nakamura discloses wherein, in said photography mode, said photographing operation is performed in accordance with a second operation of one of said

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printing start mechanism and said image data generating start mechanism (second push-button switch 28 is used for capturing image, figure 1, column 3, lines 24-28), said reproduction mode (printing operation) being subsequent to said photographing operation (column 3, lines 45-50).

Regarding claims 7 and 14, Nakamura discloses wherein said second operation is a single operation of less than a predetermine period of one of said printing operation start mechanism and said image data generating start mechanism (the second push-button switch 28 determines a timing at which a picture image is to be taken out and instructing the printer device 12 prints a hard copy, figure 1, column 3, lines 24-56).

Regarding claim 8, Nakamura discloses a printer (printer 12, figure 1) connectable to a still video camera (optical device 1, figure 1, column 3, lines 5-10), said printer comprising an image data receiving processor that receives said image data from said still video camera (inherently included in printer device 12, figure 1, column 3, lines 35-41); a printer processor that prints the image (column 3, lines 40-45); a printing operation start mechanism that activates the printing processor, said still video camera being activatable by said printing operation start mechanism in said photography mode to perform the photographing operation (first push-button 13, figure 1, column 3, lines 24-56), wherein a waiting operation is performed in said reproduction mode after said photographing operation is performed (Nakamura discloses a copy switch 17 for causing the printer device 12 to print the stored contents of a memory 16 provided in the printer 12 (column 3, lines 47-55). This clearly shows that there is "a waiting operation" after photographing operation is performed).

Regarding claim 9, Nakamura discloses wherein said printing processor is activatable, in said reproduction mode, by an image data generating start mechanism (second push-button switch 28, figure 1, column 3, lines 24-28) of an image data generating processor (controller 10, figure 1, column 3, lines 32-35) provided in said still video camera to perform said photographing operation (the second push-button 28 instructs a printing operation, figure 1, column 3, lines 24-28, lines 41-45, lines 51-55).

Regarding claim 10, Nakamura discloses wherein said printing operation start mechanism comprises a print start switch depressable to activate a printing operation (first push-button 13, figure 1, column 3, lines 24-56).

Regarding claim 11, Nakamura discloses wherein, in said photography mode, said photographing operation is performed in accordance with a first operation of one of said printing operation start mechanism and said image data generating start mechanism (first push-button switch 13 is used for capturing image, figure 1, column 3, lines 40-50), and after said photographing operation, said image data obtained by said photographing operation is printed by said printer (column 3, lines 45-50).

Regarding claim 15, Nakamura discloses an image indicating monitor (indicating device 15, figure 1, column 3, lines 45-48).

Regarding claim 16, Nakamura discloses a camera-printer system, comprising a still video camera that performs (camera 1, figure 1), in a photography mode, a photographing operation of an image by operating a release switch (second push-button switch 28, figure 1, column 3, lines 24-28); a printer (printer device 12, figure 1, column 3, lines 35-55); a print start switch (copy switch 17, figure 1, column 3, lines 45-55); an image data transmission processor (controller 10 and cable 11, figure 1, column 3, lines 35-42, column 4, lines 13-15); said photographing operation being performed in accordance with a first operation by selectively activating one of said release switch (second push-button switch 28, figure 1, column 3, lines 23-55), said image being printed by said printer, in said reproduction mode, in accordance with a second operation of said release switch after said photographing operation is performed (Nakamura discloses that after the picture image is taken by the second push-button switch 28, the picture is printed by printer 12, figure 1, column 3, lines 23-55).

It should be noted that the Applicant recites the alternative limitation “one of” in the limitation “one of said release switch and said printing start switch.” Therefore, the prior art can only read on limitation “said release switch” or limitation “said print start switch”. In this case, Nakamura discloses the second push-button switch 28 takes the image (release switch, figure 1, column 3, lines 23-55).

Regarding claim 17, see Examiner’s comment regarding claims 4 and 7.

Regarding claim 18, see Examiner’s comment regarding claim 6.

Regarding claim 19, Nakamura discloses a camera (camera 1, figure 1) that captures image data representing an image, the image data being printed by a printer (printer 12, figure 1), said camera comprising an image data generating start mechanism (second push-button 28, figure 1, column 3, lines 24-28) that initiates the capturing of the image data, the captured image data being printed by the printer in accordance with an operation by said image data generating start mechanism. (It should be noted that claim 19 only recite "*the captured image data being printed by the printer in accordance with an operation by said image data generating start mechanism.*" the claim does not require image data printed by a second operation of the image data generating start mechanism. Therefore, Nakamura patent still read on claim 19).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Hoda et al. (US 6,094,282).

Regarding claim 19, Hoda et al. disclose a camera that captures image data representing an image, the image data being printed by a printer (figure 3 shows a camera with built-in printer, column 5, lines 3-65), said camera comprising an image data generating start mechanism that initiates the capturing of the image data, the captured image data being printed by the printer in accordance with an operation by said image data generating start mechanism (figure 3, SR is a

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start switch which functions as a photography start button when photographing a subject and a printout start button when printing an image, column 5, lines 44-46).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Luong T Nguyen** whose telephone number is (703) 308-9297. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber** can be reached on (703) 305-4929.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to : (703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 whose telephone number is (703) 306-0377.

LN LN
11/29/03


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600